

## UTILITY PATENT

B&amp;D No. TN-1379A

REMARKS

Applicants have amended Claim 25 and canceled Claim 29. Claims 25-28 and 30-32 are therefore pending in the present application.

The Examiner rejected Claims 28-29 under 35 USC § 112, second paragraph for indefiniteness. This rejection is respectfully traversed.

In reviewing a claim for compliance with the second paragraph of Section 112, the Examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope. MPEP § 2173.02 (*citing Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372 (Fed. Cir. 2000)). If the scope of the invention cannot be determined from the language of the claims with a reasonable degree of certainty, a rejection under 35 USC § 112, second paragraph. *Id.* (*citing In re Wiggins*, 488 F.2d 538 (CCPA 1973)).

In the present case, Claim 28 depends upon Claim 25, and further requires that the "stored information [be] downloadable into a computer." Applicants submit that a person skilled in the art would understand that the use profile information about the power tool stored in the memory can be downloaded into a computer. The Examiner apparently understands that since the Examiner did not raise any issues with such language. Therefore, the rejection as to Claim 28 should be withdrawn.

Applicants note that Claim 29 has been canceled. However, Applicants will discuss this rejection as the subject matter of Claim 29 has been incorporated into Claim 25. Claim 25 requires that "the stored information [be] downloadable into a reader apparatus." Applicants submit that a

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person skilled in the art would understand that the use profile information about the power tool stored in the memory can be downloaded into a reader apparatus.

The Examiner's rejection does not appear to be based on unclear language in the claim, or lack of proper support, as the Examiner cited proper support to the specification for such claim. Nonetheless, the Examiner notes that "it is not clear what the criticality of including a reader is, since it is described as a transmitter of information, and not an analyzer."

It appears that the Examiner is referring to something else other than an indefiniteness rejection, since the Examiner is not arguing about the language. Nonetheless, Applicants will explain the criticality of a reader apparatus. As the Examiner knows, most computers are relatively big, compared to a small power tool, as well as fragile. Accordingly, it may be undesirable to go to a construction jobsite, where people are working with other tools, lumber, etc., with a computer. Thus, if someone desires to obtain use information from a power tool at a jobsite, it would be easier to download the information into a reader apparatus, which can be relatively small. The reader can then be connected to a computer for downloading and analysis.

The Examiner has rejected Claims 25-32 under 35 USC § 103(a) as being unpatentable over US Patent No. 4,636,961 ("Bauer"). This rejection is respectfully traversed.

Claim 25 calls for a power tool comprising a memory for storing use profile information about the tool, wherein the stored information is downloadable into a reader apparatus. Claims 26-28 and 30-32 are ultimately dependent upon Claim 25 and thus include the elements of Claim 25.

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Admittedly, Bauer discloses a power tool with a memory 15. However, Bauer does not disclose a memory for storing use profile information about the tool. Instead, Bauer discloses a power tool with a read-only memory (ROM), which is programmed with control information prior to sale. Bauer, col. 3, lns. 35-37. The Examiner admits that the ROM has values that "are fed to the control device of the motor of the tool... As a result the optimum rotary speed of the electric motor of the tool is adjusted." In other words, the ROM contains control information for controlling the rotary speed value (Bauer, col. 4, lns. 37-40), but not use profile information concerning the manner in which the user is using the power tool.<sup>1</sup>

By contradistinction, Claim 25 calls for "a memory for storing use profile information about the tool." This information would include, for example, the tool temperature, length of use, number of times the tool has been turned on, etc. (See, e.g., Specification, page 8, lines 13-14.) This allows a person to obtain this information at a later time and to analyze it. (See, e.g., Specification, page 8, line 15 to page 9, line 5.) Therefore, Bauer does not disclose or suggest all the claimed elements.

In addition, there is no suggestion to modify Bauer's preprogrammed memory storing control information with a storage memory for storing profile use information as implied by the Examiner for several reasons. First, such modification would change the principle of operation. According to the CCPA, if the proposed modification of the prior art changes the principle of operation of the prior art invention being modified, then the teachings of the reference are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349

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<sup>1</sup> The Examiner notes that Bauer also discloses a programmable ROM (PROM) which "can be programmed by the user and easily reprogrammed." Bauer, col. 4, lns. 42-44. However, the

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(CCPA 1959). In the present case, the ROM in Bauer is used for controlling the motor speed.

Since the Bauer memory does not store information as to how the user uses the tool, the principle of using a memory for controlling a parameter is changed.

Second, such modification would render the Bauer device unsatisfactory for its intended purpose. According to the CAFC, if a proposed modification renders the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). As admitted by the Examiner, the Bauer device has a memory with control information for controlling and optimizing the motor speed. If the Bauer memory is replaced with a memory for storing use profile information, then the memory will not have the necessary control information for controlling and optimizing the motor speed. Accordingly, such modification would render the Bauer device unsatisfactory for its intended purpose. For these reasons, no suggestion exists to modify Bauer as proposed by the Examiner. Therefore, Bauer cannot render Claims 25-32 unpatentable.

The Examiner also rejected to Claims 25-32 under 35 USC § 103(a) as being unpatentable over US Patent No. 5,903,462 ("Wagner"). This rejection is respectfully traversed.

Admittedly, Wagner discloses a power tool with a memory for storing performance records. However, Wagner does not disclose downloading such performance records into a reader apparatus for later analysis. Instead, Wagner discloses directly connecting the power tool to the computer for analyzing the stored information.

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information that is stored in the PROM is still control information relating to the rotary speed,

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By contradistinction, Claim 25 requires that the "stored information [be] downloadable into a reader apparatus." Such feature is critical as it allows a person to obtain the store information at the construction jobsite without bringing fragile computers to hook up to the power tool.

In addition, there is no suggestion to modify Wagner's direct connection to a computer with a separate reader apparatus because such modification would change the principle of operation. According to the CCPA, if the proposed modification of the prior art changes the principle of operation of the prior art invention being modified, then the teachings of the reference are not sufficient to render the claims prima facie obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

In Wagner, the stored information is directly obtained and analyzed by the computer connected to the power tool, rendering the need for an additional reader apparatus superfluous. Since the reader apparatus is superfluous, adding a reader apparatus to Wagner would change the principle of obtaining and analyzing information. Accordingly, suggestion exists to modify Wagner as proposed by the Examiner. Therefore, Wagner cannot render Claims 25-28 and 30-32 unpatentable.

In view of the foregoing, all the claims are patentable and the application is believed to be in condition for formal allowance. Reconsideration of the application and allowance of Claims 25-28 and 30-32 are respectfully requested.

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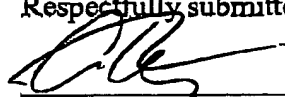
not information as to how the user is using the tool.

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No fee is due for the present amendment. Nevertheless, the Commissioner is authorized to charge payment of any fees due in processing this response, or credit any overpayment to Deposit Account No. 02-2548.

Respectfully submitted,



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Attachment for Claim Amendments

The following is a marked up version of each amended claim in which underlines indicates insertions and brackets indicate deletions.

25. (Amended) A power tool comprising:

a memory for storing use profile information about the tool, wherein the stored information  
is downloadable into a reader apparatus.

Please cancel Claim 29.